



PATENT APPLICATION

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JFW

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Tetsuo NISHIKAWA et al  
Title : THERMOPLASTIC RESIN COMPOSITION  
Serial No. : 09/973 646 Group: 1714  
Confirmation No.: 6210  
Filed : October 9, 2001 Examiner: Shosho  
Atty. Docket No.: Nanjo 1

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**FIRST CLASS MAILING CERTIFICATE**

Sir:

I hereby certify that this correspondence is being deposited with the United States Postal Service under 37 CFR 1.8 as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 27, 2006.

  
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Correspondence: Reply Brief  
dated April 27, 2006  
including enclosures listed thereon

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**REPLY BRIEF**

Sir:

This Reply Brief is filed pursuant to the provisions of 37 CFR §41.41 and is directed to points of arguments raised by the Examiner in the Examiner's Answer.

In the Examiner's Answer, the Examiner states that the Declarations Under 37 CFR 1.132 dated October 14, 2003 and February 26, 2004 are not successful in removing Sakaki et al as a reference in the present application because the first Declaration signed by Sakaki, Mizoguchi and Nishikawa did not refer to Haruta and the second Declaration signed by Haruta did not refer to Sakaki, Mizoguchi and Nishikawa. In support of this position, the Examiner has not cited any official authority other than her opinion.

As pointed out by Appellants during the prosecution of the present application, the first Declaration Under 37 CFR 1.132 was filed with only three of the inventors' signatures due to the fourth inventor being hospitalized and quarantined. The second Declaration Under 37 CFR 1.132 was submitted after the fourth inventor was taken out of quarantine. Collectively, the four inventors of the present invention have unequivocally stated that they are the true inventors of the thermoplastic resin composition containing a thermoplastic elastomer and tungsten powder disclosed in U.S. Patent No.

6 364 422. Appellants respectfully submit that the two Declarations are sufficient to remove U.S. Patent No. 6 364 422 as a reference against the present application. If the Examiner has authority to the contrary, other than her opinion, it has not been provided in the present application.

There also appears to be confusion on the Examiner's part regarding language in the Declarations which state that the balance weight for a vehicle wheel was invented independently by the inventors of U.S. Patent No. 6 364 422. The Examiner is of the opinion that this statement contradicts the rest of the Declaration. Appellants respectfully submit that this statement is entirely consistent with the remaining language in the Declarations in that the inventive entity of U.S. Patent No. 6 364 422, which included two inventors of the present invention, independently invented the balance weight for a vehicle wheel, which comprises a metal clip comprising a hook portion having a cross-sectional shape corresponding to a flange edge portion of the wheel and a leg portion for retaining a weight, which is capable of independently close-contact and fixing to the flange edge portion. Although the material for the weight was arrived at by the present inventors, the balance weight was developed by an inventive entity independent from that of the present invention. That is, the present inventors did not invent the balance weight for a vehicle wheel of U.S. Patent No. 6 364 422, the present inventors invented the material that was used to manufacture the weight that constitutes a part of the balance weight. As such, Appellants respectfully submit that the language of the Declarations Under 37 CFR 1.132 are consistent.

The Examiner also has put forth the position that the Declarations contain no statement that Sakaki and Mizoguchi and Nishikawa and Haruta are the sole inventors of the subject matter described and claimed in this application and also that disclosed in the printed publication. The inventors of the present invention cannot state that they are the sole inventors of the balance weight for a vehicle wheel of U.S.

Patent No. 6 364 422 because they did not invent the balance wheel, only the material of the weight. The Declarations Under 37 CFR 1.132 conclusively state this fact and, as such, are sufficient to remove U.S. Patent No. 6 364 422 as a reference against the present claims.

In the Examiner's Answer, the Examiner has maintained the rejection of Claims 1, 4-7, 16-19, 22 and 23 as being anticipated under 35 USC 102(c) by U.S. Patent No. 6 300 399 to Gallucci et al. The Examiner states that the Gallucci et al reference discloses a composition comprising 1-10% of a thermoplastic elastomer, which can include a styrene-based elastomer, and 60-95% tungsten powder. However, as pointed out by Appellants during the prosecution of the present application, the styrene-based thermoplastic elastomer of the present invention is an optional ingredient in Gallucci et al and the only specific examples of Gallucci et al that contain a styrene-based thermoplastic elastomer, Examples 3, 4, 9 and 10, only contain 80-81% of tungsten powder. The claims on appeal require that at least 85 wt.% of tungsten powder be present in the composition. Therefore, this reference clearly does not anticipate the currently claimed invention under 35 USC 102 since the styrene-based resin is optional and all of the specific examples that contain the styrene-based resin do not contain the minimum amount of tungsten powder required by the presently claimed invention. While a "fair reading" of Gallucci et al may make a showing of prima facie obviousness under 35 USC 103(a), in no way does this reference specifically disclose the presently claimed invention as is required by 35 USC 102. As such, the Examiner's rejection of Claims 1, 4-7, 16-19, 22 and 23 under 35 USC 102(e) as being anticipated by Gallucci et al clearly is in error.

The Examiner additionally puts forth the argument that the data contained in the present specification is not persuasive in establishing unexpected or surprising results over the cited prior art. Appellants respectfully disagree. Example 1 is identical to Comparative Example 1 except that

Comparative Example 1 contained 98.0 wt.% of the tungsten powder. As shown in the discussion under Comparative Example 1, this composition presented such a load to the extruder that pellets could not be obtained. Comparative Example 2 used 18 wt.% of the same resin as used in Example 1 and 82 wt.% of tungsten powder having an average diameter of 5 microns which was smaller than the 13 micron tungsten powder used in Example 1. The Examiner argues that Comparative Example 2 cannot be considered because of the difference in average particle diameter of the tungsten powder. However, Examples 3 and 4 both use tungsten powder having the same or a smaller particle diameter as the tungsten powder of Comparative Example 2. Therefore, there is no reason to believe that the differences in particle diameters between the tungsten powder used in the Examples and in the Comparative Examples is a critical factor. Comparative Example 3 used the same thermoplastic elastomer as Example 4 and Comparative Example 4 used a polyester instead of a thermoplastic elastomer. As pointed out previously, the compositions tested in the Comparative Examples are closer to the presently claimed invention than the compositions disclosed in Gallucci et al. That is, Comparative Examples 2 and 3 are closer to the presently claimed invention than any specific example disclosed in Gallucci et al. As shown by the results in Table 2 of the present specification, the composition of the Comparative Examples were unsatisfactory. Therefore, Appellants respectfully submit that the objective evidence of record in the present application is more than sufficient to rebut a showing of prima facie obviousness under 35 USC 103(a) over the Gallucci et al reference.

Reversal of the Examiner's rejection of the presently  
claimed invention is respectfully solicited.

Respectfully submitted,

  
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